

REMARKS

Applicant hereby amends claims 1, 4, 5, 8-13, and 23 and cancels claim 18. Claims 2-3, 6-7, 15, 17, 24 and 29-58 were previously canceled. Claims 1, 4-5, 8-14, 16, 19-23, 25-28 remain pending in the application, with claims 1, 13, and 23 being in independent form.

In an Office Action¹ the Examiner took the following actions:

rejected claims 1, 4-5, and 8-12 under 35 U.S.C. § 112, second paragraph;

rejected claims 1 and 11-12 under 35 U.S.C. § 103(a) as being unpatentable over Betsy Wade, *Customs aims to keep their pledge; [Final Edition]*, San Antonio Express-News, San Antonio, Tex., Mar. 30, 1997, at 3K ("Wade") in view of U.S. Patent No. 6,115,690 to Wong ("Wong");

rejected claims 4-5 and 8-10 under 35 U.S.C. § 103(a) as being unpatentable over *Wade* in view of *Wong* and further in view of Coalition for Secure & Trade-Efficient Borders, *Rethinking our Borders: A Plan for Action*, Dec. 3, 2001 ("*Coalition*");

rejected claims 13-14, 16, 19-24, and 24-28 under 35 U.S.C. § 103(a) as being unpatentable over *Coalition* in view of *Wong*; and

rejected claim 18 under 35 U.S.C. § 103(a) as being unpatentable over *Coalition* in view of *Hijacked Jetliners Used as Weapons of Mass Destruction*, Air Safety Week, Vol. 15, Iss. 35, at 1, N.Y. Sep. 17, 2001 ("*Air Safety Week*").

¹ The Office Action may contain a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

Rejection of Claims 1, 4-5, and 8-12 under 35 U.S.C. § 112(2):

In the Office Action, the Examiner rejected claims 1, 4-5, and 8-12 under 35 U.S.C. § 112, second paragraph. According to the Examiner, the use of the terms “capabilities” and “capability” with respect to the system of claim 1 is unclear. Applicant respectfully disagrees that this language is not clear. However, after Applicant’s claim amendments, claims 1, 4-5, and 8-12 no longer include the term “capabilities” or “capability.” Applicant therefore respectfully requests that the § 112 rejection of these claims be withdrawn.

Rejection of Claims 1 and 11-12 under 35 U.S.C. § 103(a):

Applicant respectfully traverses the rejection of claims 1 and 11-12 under 35 U.S.C. § 103(a) as being unpatentable over *Wade* in view of *Wong*. A *prima facie* case of obviousness has not been established.

The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. See M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007). Such an analysis should be made explicit and cannot be premised upon mere conclusory statements. See *id.* “A conclusion of obviousness requires that the reference(s) relied upon be enabling in that it put the public in possession of the claimed invention.” M.P.E.P. § 2145. Moreover, “[i]n determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.” M.P.E.P. § 2141.02(I), internal citations omitted (emphasis in original).

"[T]he framework for the objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). . . . The factual inquiries . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the differences between the claimed invention and the prior art." M.P.E.P. § 2141(II). "Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art." M.P.E.P. § 2141(III).

None of the cited references, whether taken alone or in combination, teaches or suggests each and every element of Applicant's amended independent claim 1. For example, *Wade* fails to teach or suggest at least Applicant's claimed system including

. . . a collect, analyze, and communicate intelligence business process for collecting information about individuals or trade and transforming said information into intelligence to detect and communicate potential individual or trade risks, wherein the collect, analyze, and communicate intelligence business process includes a risk assessment element that applies neural networks and rules-based algorithms to transform the information into the intelligence . . .

as recited in amended independent claim 1. The Examiner asserts that *Wade* teaches "[t]he matching of names in IBIS" and that

. . . after the comparison of the collected data with the IBIS database, passengers that do not match are waved through, therefore, it is inherent that passenger [sic] that do match are not waved through and are obviously detained pending further investigation. Therefore, the information from the scanned passports is transformed into intelligence as a result of the comparison with the IBIS database such that matched passengers are subject to increased scrutiny over unmatched passengers. This comparison allows for the detection and communication of potential risks.

Office Action at 4-5. Applicant disagrees that *Wade*'s alleged teaching of the use of name-matching in IBIS teaches the "transformation" of "information into intelligence" as recited in independent claim 1. Even if *Wade* did provide such a teaching, however, *Wade* fails to teach or suggest a collect, analyze, and communicate intelligence business process that "includes a risk assessment element that applies neural networks and rules-based algorithms to transform the information into the intelligence" as recited in amended claim 1.

Wong does not remedy this deficiency. As Applicant has previously stated, *Wong* teaches nothing about how to transform information collected by various border management business processes into intelligence. *Wong* relates to "software that enables end-to-end, business-to-business Web commerce" and "that automates . . . the various aspects of running a successful and profitable business." *Wong* at 4:7-12. *Wong* does not teach or suggest any sort of business process that includes a "risk assessment element" as recited in claim 1.

In view of the above, the Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the prior art and the claimed invention. Consequently, the Office Action has failed to clearly articulate a reason why claim 1 would have been obvious to one of ordinary skill in view of the prior art. Therefore, a *prima facie* case of obviousness has not been established for at least the reasons discussed above and the Examiner should withdraw the rejection of amended independent claim 1 under 35 U.S.C. § 103(a). Applicant respectfully requests the withdrawal of the 35 U.S.C. § 103(a) rejection of claims 1 and its respective dependent claims 11 and 12.

Rejection of Claims 4-5 and 8-10 under 35 U.S.C. § 103(a):

Applicant respectfully traverses the rejection of claims 4-6 and 8-10 under 35 U.S.C. § 103(a) as being unpatentable over *Wade* in view of *Wong* and further in view of *Coalition*. A *prima facie* case of obviousness has not been established. None of the cited references, whether taken alone or in combination, teaches or suggests each and every element of Applicant's amended independent claim 1, from which claims 4-5 and 8-10 depend. As discussed above in connection with the rejection of claims 1 and 11-12, neither *Wade* nor *Wong* teaches or suggests at least Applicant's claimed system including

. . . a collect, analyze, and communicate intelligence business process for collecting information about individuals or trade and transforming said information into intelligence to detect and communicate potential individual or trade risks, wherein the collect, analyze, and communicate intelligence business process includes a risk assessment element that applies neural networks and rules-based algorithms to transform the information into the intelligence . . .

as recited in amended independent claim 1.

Coalition does not cure this deficiency. The Examiner asserts that *Coalition* teaches the transformation of data into intelligence. Office Action at 9 (addressing claim 13). Applicant disagrees that *Coalition* teaches the "transformation" of "information into intelligence" as recited in independent claim 1, from which claims 4-5 and 8-10 depend. Even assuming that *Coalition* did provide such a teaching, however, *Coalition* fails to teach or suggest a collect, analyze, and communicate intelligence business process that "includes a risk assessment element that applies neural networks and rules-based

algorithms to transform the information into the intelligence” as recited in amended independent claim 1 as amended, from which claims 4-5 and 8-10 depend.

In view of the above, the Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the prior art and the claimed invention. Consequently, the Office Action has failed to clearly articulate a reason why claim 1, from which claims 4-5 and 8-10 depend, would have been obvious to one of ordinary skill in view of the prior art. Therefore, a *prima facie* case of obviousness has not been established for at least the reasons discussed above. Applicant respectfully requests the withdrawal of the 35 U.S.C. § 103(a) rejection of claims 4-5 and 8-10, which depend from independent claim 1.

Rejection of Claims 13-14, 16, 19-24, and 24-28 under 35 U.S.C. § 103(a):

Applicant respectfully traverses the rejection of claims 13-14, 16, 19-24, and 24-28 under 35 U.S.C. § 103(a) as being unpatentable over *Coalition* in view of *Wong*. A *prima facie* case of obviousness has not been established. None of the cited references, whether taken alone or in combination, teaches or suggests each and every element of Applicant's amended independent claims 13 or 23. As the Examiner noted, “Coalition does not disclose a risk scoring and analytics application.” Office Action at 15 (addressing claim 18). *Wong* does not cure this deficiency because *Wong* does not teach or suggest any sort of risk scoring.

In view of the above, the Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the prior art and the claimed invention. Consequently, the Office Action has failed to clearly articulate a reason why claims 13 and 23, from which claims 14, 16, 19-22, and 24-28

depend, would have been obvious to one of ordinary skill in view of the prior art.

Therefore, a *prima facie* case of obviousness has not been established for at least the reasons discussed above. Applicant respectfully requests the withdrawal of the 35 U.S.C. § 103(a) rejection of amended independent claims 13 and 23, as well as their dependent claims 14, 16, 19-22, and 24-28.

Rejection of Claim 18 under 35 U.S.C. § 103(a):

Applicant has canceled claim 18, thereby rendering the rejection of claim 18 moot.

CONCLUSION

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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